

Notice of Allowability

Application No.

10/750,920

Examiner

Vinh T Luong

Applicant(s)

YAMANAKA, MASAHIRO

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/2/05.
2. ☒ The allowed claim(s) is/are 12-21.
3. ☒ The drawings filed on 31 December 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 5/2/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


Vinh T. Luong
Primary Examiner

Art Unit: 3682

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2005 has been entered.

2. Claims 12-21 are allowed.

3. The following is an examiner's statement of reasons for allowance: the claims are allowed due to the limitation "wherein the threaded outer peripheral surface (388) is *dimensioned to* screw within an inner peripheral surface of the axle (59) to fasten the axle bolt (380) *so that* the axle bolt (380) rotates together with the axle (59) during pedaling" (emphasis and referential numerals added) in amended claim 12.

At the outset, the Examiner considers *all* words in Applicant's claims in judging the patentability of the claims against the prior art as mandated by the Court. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) and MPEP 2143.03.

In the instant case, the Examiner agrees with Applicant's contention on page 4 of the Amendment filed on May 2, 2005. The recitation "dimensioned to" constitutes a positive structural limitation. See *Watts v. XL Systems, Inc.*, 56 USPQ2d 1836, 1840 (Fed. Cir. 2000). In other words, Applicant's claim language "dimensioned to screw within an inner peripheral surface of the axle to fasten the axle bolt . . ." limits the claimed invention to structures utilizing the axle bolt 380 screwed to the inner peripheral surface of the axle 59 that is rotatably fitted within a bottom bracket 33 of a bicycle frame 18 as recited in the preamble of claim 12 and shown in Applicant's Fig. 3.

Moreover, the preamble of claim 12 is accorded the effect of a distinguishing limitation since the body of claim 12 sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble. *In re Casey*, 152 U.S.P.Q. 235 (CCPA 1967); *Kropa v. Robie*, 88 U.S.P.Q. 478 (CCPA 1951); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 U.S.P.Q.2d 1286 (CAFC 2001); and *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 62 USPQ2d 1781 (CAFC 2002). In fact, Applicant's "wherein" clause quoted above sets forth structure "the threaded outer peripheral surface" which refers back to, is defined by, or otherwise draws life and breadth from "the axle" in the preamble. Therefore, the Examiner further agrees with Applicant's contention regarding the preamble of claim 12. See page 4 of the Amendment above.

Further, Applicant's "so that" clause in claim 12 also constitutes a functional limitation. See *In re Chandler*, 254 F.2d 396, 400, 117 USPQ 361, 364 (CCPA 1958) and unpublished *Burns v. Horzewski*, 40 USPQ2d 1374, 1375 (Bd. Pat. App. & Inter. 1996). In this case, the closest prior art Nagano'149 (EP 0 512 149 A1) teaches the axle bolt 3 for an axle 5. However, Nagano'149's axle 5 is not rotatably fitted within a bottom bracket of a bicycle frame and coupled to a crank arm as claimed. Nagano'149's axle 5 is actually corresponding to Applicant's bottom bracket'33 as seen by comparison of Nagano'149's Fig. 2 and Applicant's Fig. 3 and described in column 3, lines 10-19 of Nagano'149. Consequently, Nagano'149's axle bolt 3 is *not* capable of rotating together with Nagano'149's axle 5. If one having ordinary skill in the art makes Nagano'149's axle bolt 3 to be rotated together with Nagano'149's axle/bottom bracket 5, one would destroy Nagano's axle/bottom bracket 5, *i.e.*, one would render Nagano'149's crank axle unit to be inoperative for its intended design.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 571-272-7099. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

May 10, 2005



Vinh T. Luong
Primary Examiner